

REMARKS

New claims 23-40 are currently being added. Basis for the aforementioned new claims can be found throughout Applicant's specification, including page 2, line 15, through page 3, line 7. All the newly added claims depend directly or indirectly from independent claim 17. Accordingly, Applicant respectfully believes since new claims 23-40 necessarily include all of the limitations of base claim 17 therein, no additional search needs to be performed by the Examiner with respect to the newly added claims.

The amendments presented herein do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, the Examiner is respectfully requested to enter these amendments.

1. Allowable Subject Matter

Applicant kindly thanks the Examiner for acknowledging claims 17-22 are patentably distinct from U.S. Patent 5,286,791 (herein referred to as DeNicola, Jr. et al.").

2. Rejection of Claims 17-22 Under 35 U.S.C. 112, 1st Paragraph

Applicant respectfully traverses the rejection of claims 17-22 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In particular, the instant Office Action states,

Claims 17-22 are rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In view of the Specification (page 3, lines 2-7) 'The olefin polymer rubber of component (B) used in the polyolefm composition of the present invention can be a poly(ethylene-co-C₃-C₁₀ α-olefin) or poly(ethylene-co-propylene-co-C₄-C₁₀ α-olefin) having an ethylene content preferably from 65 to 80% by weight', there is no support for 'more than 70% by weight of ethylene' cited in lines 8-9 of claim 17.

However, Applicant respectfully traverses the Examiner's conclusion above.

First and foremost, Applicant respectfully notes that the current Office Action states,

Claims 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement requirement**. . . . In view of the Specification (page 3, lines 2-7) 'The olefin polymer rubber of component (B) used in the polyolefm composition of the present invention can be a poly(ethylene-co-C₃-C₁₀ α-olefin) or poly(ethylene-co-propylene-co-C₄-C₁₀ α-olefin) having an ethylene content preferably from 65 to 80% by weight', **there is no support** for 'more than 70% by weight of ethylene' cited in lines 8-9 of claim 17. (Emphasis added)

However, Applicant respectfully believes the Examiner is inadvertently confusing the enablement requirement prong of 35 U.S.C. §112, first paragraph, with the written description requirement prong of 35 U.S.C. §112, first paragraph. See MPEP §2163 and §2164. In fact, to satisfy the enablement requirement of

35 U.S.C. §112, first paragraph, the disclosure, when filed, needs to contain sufficient information regarding the claimed subject matter as to enable one skilled in the art to make and use the claimed subject matter. In particular, the question as to whether the specification meets the enablement requirement revolves around whether the experimentation needed to practice the invention is *undue* or *unreasonable*. See MPEP §2164.01 and *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). In this respect, Applicant respectfully believes the instant rejection falls short of explaining *why* undue experimentation would be required to practice Applicant's currently claimed compositions. For this reason, if in fact the current rejection is suppose to be a rejection under 35 U.S.C. 112, first paragraph, for failing to satisfy the enablement requirement, Applicant respectfully believes the instant rejection should be withdrawn.

Notwithstanding, Applicant responds as follows if the instant rejection is suppose to be a rejection under 35 U.S.C. §112, first paragraph, for failing to satisfy the written description requirement. See MPEP §2163. As outlined in MPEP §2163, there is no *in haec verba* requirement to satisfy the written description requirement under 35 U.S.C. §112, first paragraph. In fact, as outlined in the aforementioned section of the MPEP, "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date

sought, applicant was in possession of the invention as now claimed." See *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. Additionally, it is sufficient to satisfy the written description requirement in 35 U.S.C. 112, first paragraph, inasmuch that the specification, "convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed." See *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976), and *In re Ruschig*, 379 F.2d 990, 996, 154 U.S.P.Q. 118, 123 (C.C.P.A. 1967). Furthermore, the disclosure must, "allow one skilled in the art 'to visualize or recognize the identity of' the subject matter purportedly described." See *Koito Mfg Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154 (Fed. Cir. 2004), quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 953, 968 (Fed. Cir. 2002).

With respect to whether the currently claimed, "more than 70% by weight of ethylene" in component (B) in Applicant's currently claimed compositions satisfies the written description requirement of 35 U.S.C. §112, first paragraph, Applicant's specification states on page 1, line 31 through page 2, line 7,

Therefore an object of the present invention is a polyolefin composition comprising (percentage by weight):

(A) from 60 to 85%, preferably 60 to 80%, of a broad molecular weight distribution propylene polymer (component A) having a polydispersity index from 5 to 15 and melt flow rate of from 20 to 78 g/10 min, preferably from 40 to 75, more preferably from 40 to 70 g/10 min (according to ASTM-D 1238, condition L); and

(B) from 15 to 40%, preferably 20 to 40%, of a partially xylene-soluble olefin polymer rubber (component B) containing **at least 65% by weight of ethylene**. (Emphasis added)

Therefore, as outlined above, Applicant's specification clearly states component (B) can comprise **at least 65%** by weight of ethylene. This is further supported given original claim 1 echoed the same ethylene content for component (B), and is further supported by Applicant's examples. Accordingly, Applicant respectfully believes one skilled in the art would clearly recognize Applicant's specification was in possession of the currently claimed ethylene content range of more than 70% by weight for component (B) at the time of filing, given Applicant's specification clearly articulates component (B) can comprise at least 65% by weight of ethylene. In other words, since one skilled in the art would clearly recognize that component (B) can comprise at least 65% by of ethylene, given the explicit disclosure in Applicant's specification, then one skilled in the art would clearly recognize that Applicant was in possession of Applicant's currently claimed compositions, wherein component (B) comprises more than 70% by weight of ethylene, at the time of filing. In fact, as noted *supra*, it is not necessary that the claimed subject matter be described in *ipsis verbis* to satisfy the written description requirement of 35 U.S.C. §112. See *Heymes v. Takaya*, 6 U.S.P.Q.2d 1448 (BPAI 1988),

aff'd, 10 U.S.P.Q.2d 1473 (Fed. Cir. 1989). Additionally, see *Wertheim* [Id.] in which Wertheim narrowed the range of solids concentration of coffee extract to between 35% and 60%, even though Wertheim originally claimed 25-60% and there was no literal support for the newly narrowed range. In fact, the CCPA held that the U.S. Patent and Trademark Office failed to establish a *prima facie* case of noncompliance with the written description requirement even though there was no literal support for the narrowed range.

In light of the facts outlined above, Applicant respectfully believes claims 17-22 satisfy 35 U.S.C. §112, first paragraph, including the enablement and written description requirements, and that undue experimentation is not required and that one of ordinary skill in the art would recognize Applicant was in possession of the currently claimed inventive subject matter at the time of filing. As such, Applicant respectfully believes the current rejection should be withdrawn.

3. Rejection of Claims 8-9, 11, 13 and 15-16 Under 35 U.S.C.

§102 (b)

Applicant has cancelled claims 8-9, 11, 13, and 15-16 rendering the rejection thereof moot. Accordingly, Applicant respectfully requests the instant rejection to be withdrawn.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection, and allow pending claims 17-40. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner with any questions or comments if it is believed such contact will expedite prosecution for this application.

Respectfully submitted,

By: _____

Jarrod N. Raphael
Registration No. 55,566
Customer No. 34872

Date: April 6, 2009
Basell USA Inc.
Delaware Corporate Center II
2 Righter Parkway, Suite 300
Wilmington, Delaware 19803
Telephone No.: 302-683-8176
Fax No.: 302-731-6408

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